

## **REMARKS/ARGUMENTS**

### **Status of the Claims**

Upon entry of the present amendment, claims 17-35 and 37-38 are pending. Claims 17-35 are withdrawn as directed to a non-elected invention. Claim 36 is canceled without disclaimer or prejudice to renewal. Claims 37-38 are presented for examination. Claims 27 and 37 are amended to set forth a murine Fuc-TVII enzyme comprising a catalytic domain that is encoded by a nucleic acid sequence segment that is identical to a polynucleotide that is amplified using murine mRNA or cDNA as a template by a 5' primer as shown in SEQ ID NO:3 and a 3' primer as shown in SEQ ID NO:4. Support is found, for example, on page 47, lines 5-15.

### **Request for Rejoinder under M.P.E.P. § 821.04**

Pursuant to M.P.E.P. § 821.04, Applicants respectfully request rejoinder of method claims 27-35. In accordance with M.P.E.P. § 821.04, applicants have amended claim 27 to correspond to the scope of claim 37.

### **Rejection under 35 U.S.C. § 112, second paragraph**

The Examiner has rejected claim 37 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. The Examiner objects that the claim does not point out a source of template. In response, Applicants have amended claim 37 to set forth a source of template. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

### **Rejection under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 37 and 38 under 35 U.S.C. § 103(a) as allegedly rendered obvious over U.S. Patent No. 5,858,752 ("Seed") in view of Sasaki, *et al.*, *J Biol Chem* (1994)269:14730-14737 ("Sasaki"). This rejection is respectfully traversed because Seed is not prior art, and Sasaki does not disclose or suggest any murine Fuc-TVII enzyme.

As the Examiner appreciates, the present application claims priority to U.S. Patent Appl. No. 08/613,098, filed March 8, 1996. U.S. Patent No. 5,858,752 was filed on June 7, 1995—less than 1 year prior to the March 8, 1996 filing date of the '098 application. Therefore, Seed is cited as art under 35 U.S.C. § 103(a)/102(e).

Applicants provide with this response a Declaration under 37 U.S.C. § 1.131 signed by co-inventor Dr. Kevin M. Gersten. The Rule 131 Declaration describes how forward (5') and reverse (3') primers corresponding to SEQ ID NO:3 and SEQ ID NO:4 were designed and used to amplify the stem region and catalytic domain from a nucleic acid template encoding murine FucT-VII prior to the June 7, 1995 filing date of U.S. Patent No. 5,858,752. Exhibit A that accompanies the Rule 131 Declaration shows an order form for primers corresponding to SEQ ID NO:3 (primer 624B) and SEQ ID NO:4 (primer 625B). Exhibit B accompanying the Rule 131 Declaration describes how the primers were used to amplify the stem region and catalytic domain of a nucleic acid sequence encoding murine FucT-VII from a nucleic acid sequence encoding murine FucT-VII. This was done before the June 7, 1995 filing date of Seed.

Exhibits A and B provide objective evidence that the present invention was conceived of and reduced to practice before the June 7, 1995 filing date of U.S. Patent No. 5,858,752. Therefore, the Seed '752 patent is not prior art.

Sasaki alone does not render the present invention obvious. Sasaki discloses expression cloning of a *human* alpha-1,3-fucosyltransferase VII, but does not disclose or suggest anything about *any murine* fucosyltransferases, much less a murine fucosyltransferase VII or a subsequence comprising the stem region and catalytic domain of a murine fucosyltransferase VII. At the time of the disclosure of Sasaki, those of skill did not know that a murine fucosyltransferase VII existed.

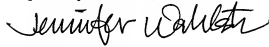
Because Seed is not prior art and Sasaki does not disclose or suggest any murine FucT-VII enzyme, the combined disclosures of Seed and Sasaki do not render the present invention obvious. Accordingly, the Examiner is respectfully requested to withdraw the present invention.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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Attachments  
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